



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,744	09/01/2006	Stephan Neffgen	GLAWE-13093	3419
72960	7590	01/08/2009		
Casimir Jones, S.C. 440 Science Drive Suite 203 Madison, WI 53711			EXAMINER KWAK, JAE J	
			ART UNIT 4131	PAPER NUMBER
			MAIL DATE 01/08/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,744

Applicant(s)

NEFFGEN ET AL.

Examiner

JAE KWAK

Art Unit

4131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/US)
- Paper No(s)/Mail Date 02/07/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 1-14, 16-26 are objected to because of the following informalities: The term "characterized in that" should be corrected to "wherein". Appropriate correction is required.
2. Claims 4-15, 19-26 are objected to under 37 CFR 1.75(c) because of improper multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claims 4-15, 19-26 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding to claim 1-26, the phrase "preferably" and "more preferably" renders the claim indefinite because it is unclear whether the limitation following the phrase are part of the claimed invention.

Regarding to claim 13, line 2 the phrase "or" renders the claim indefinite because it is unclear whether the "it" refers to "initiator or a number of initiator" or "coinitiator or a number of coinitiators".

Claim 15 provides for the use of dental material, but, since the claim does not set forth

any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Angeletakis et al. (US Patent 6,593,395 B2).

Angeletakis et al. discloses a dental composite comprising resins and structure filler of ground particles wherein the average particles size are between about 0.05 μm to 0.5 μm (Col. 3 line 33) with 10% by volume to about 70% by volume (Claim 1), and aggregated particles reads on the "weakly agglomerated particles" (Col. 4 line 44). Lastly examples of organic binders are also disclosed in **Table 1** (Col. 6 lines 13-25). Furthermore, Angeletakis et al. discloses surface treatment of these nanoscale fillers. (Col. 5 lines 53-60).

The recitation of instant claim 2 can be found in Angeletakis et al. (Table 1 Col. 6).

The recitation of instant claims 3-4 can be found in Angeletakis et al. (Table 2 Col. 8).

The recitation of instant claim 7, 11 can be found in Angeletakis et al. (Col. 6 lines 26-32).

The recitation of instant claims 8-10 can be found in Angeletakis et al. (Col. 4 lines 25-45).

The recitation of instant claim 12 can be found in Angeletakis et al. (Col. 5 line line 55)

The recitation of instant claim 13 can be found in Angeletakis et al. (Col. 5-6 line 65-5).

The recitation of instant claim 14 can be found in Angeletakis et al. (Table 2).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angeletakis et al. (US Patent 6,593,395 B2).

The disclosure of Angeletakis et al. is adequately set forth in paragraph 6 and is incorporated herein by reference.

The difference between the present claims and the disclosure of Angeletakis et al. is the requirement specific order for the contact. The Case Law has held that selection of any order of

performing process steps is prima facie obvious in the absence of new or unexpected results. In re Burhans, 154 F.2d 690, 69 USPQ 330 CCPA 1946 . It would have been obvious to ordinary skill in art at the time of inventions was made to alternate the order to achieve the claimed invention.

Allowable Subject Matter

9. Claims 5-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Prior of reference of record did not teach or fairly suggest specific component.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAE KWAK whose telephone number is (571)270-7339. The examiner can normally be reached on Monday to Friday 8:00 A.M. EST 5:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ling-Siu Choi/
Primary Examiner, Art Unit 1796

J.K.